

Claims 5-9

Claims 5-9 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based, as recited in the December 16, 2003 Office Action (the "Office Action"). As justification for improper recapture, the Office Action recites "... the applicant added to claims 1 and 6 (renumbered as claim 3 in patent 5,388,260 which was issued from the prosecution) the limitation 'and a controller coupled ...' in such a way that the 'controller' was listed as included within (included in the list of elements making up) an 'automated storage library' (see also discussion of errors on page 5 and 6 of the reissue oath/declaration where the insertion of the 'controller' within the 'automated storage library' was described as an error." (Office Action, Page 3, paragraph 1) (*original emphasis*).

In contrast to the position expressed in the Office Action, adding a limitation to a claim does not in and of itself support improper recapture. *See, e.g., Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). Rather, to determine whether an applicant surrendered particular subject matter, one should look to the prosecution history for arguments and changes to the claims *made in an effort to overcome a prior art rejection*. *See Mentor* at 998 F.2d at 995-96, 27 USPQ2d at 1524, 25. Moreover, the argument that the claim limitation defined over the rejection, if made, *must be specific as to the limitation*; rather than a general statement regarding the claim as a whole. *See* MPEP 1412.02.

Nowhere does the Office Action provide any support that the purported amendment to claims 1 and 6 was made in an effort to overcome a prior art rejection, and that the arguments to such amendment were specific as to the limitation, as required by the authorities cited above. Rather, as provided in the reissue oath/declaration, the insertion of the controller within the automated storage library was described as error. As such, claims 5-9 do not represent an improper recapture. Accordingly, Applicants respectfully submit that claims 5-9 are allowable and request a notice of allowance to this effect.

CONCLUSION

In view of the remarks set forth herein, all pending claims are believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on <u>June 16, 2004</u> .	
<u>John C. Kennel</u>	<u>6/16/04</u>
Signature	Date of Signature

Respectfully submitted,

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